

REMARKS

By this Amendment, Applicants amend claims 3, 12, and 16. Claims 3-5, 7-9, 12, 13, 16, and 17 remain currently pending.

In the Office Action, the Examiner rejected claims 3-5, 7-9, 12, 13, 16, and 17 under 35 U.S.C. § 112, second paragraph, as being indefinite; rejected claims 3-5, 7-9, 12, 13, and 16 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,408,282 to Buist ("Buist"); and rejected claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Buist in view of Hirotaka et al., "Application Of Neural Network To Technical Analysis Of Stock Market Prediction" (April 27, 1998) ("Hirotaka").¹

Regarding the Information Disclosure Statement filed 12/6/2005

The Examiner did not consider all listed documents in the PTO/SB/08 form of the Information Disclosure Statement (IDS) filed 12/6/2005, and indicated that "no translation" was provided for the non-considered foreign documents. Applicants respectfully submit that "[w]here the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office." M.P.E.P. § 609.04(a)(III).

Because Applicants submitted relevant Examination Reports by British Patent Office with the IDS filed 12/6/2005, Applicants have met the requirements of M.P.E.P. § 609.04(a)(iii) and the Examiner is required to consider the documents he lined

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

through. Accordingly, Applicants respectfully request the Examiner consider the listed documents and indicate that they were considered by making appropriate notations on the relevant form. A copy of the PTO/SB/08 form is attached for the Examiner's convenience.

Regarding the rejection under 35 U.S.C. § 112, second paragraph

Applicants respectfully traverse the rejection of claims 3-5, 7-9, 12, 13, 16, and 17 under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner alleges that "[r]egarding claim 3, 12, and 16, the phrase 'a technical index associated with a stock market stock average' renders the claim indefinite. It is unclear how a technical index can be associated with a stock market stock average." (Office Action at 2.) Applicants respectfully disagree. For example, the specification explicitly states that "conditions concerning various technical indexes including various indexes such as TOPIX and Nikkei stock futures, comparison with stock prices on the day before (ratio to the day before), the deviation rate from the transfer mean value, and RSI obtained from the psychological line can be input." Specification, page 12.

However, to expedite the prosecution of this application, Applicants have amended claims 3, 12, and 16 to recite "a technical index calculated by a stock market average." Accordingly, Applicants respectfully request withdrawal of the Section 112 rejection of claims 3-5, 7-9, 12, 13, 16, and 17.

Regarding the rejection under 35 U.S.C. § 102(e)

Applicants respectfully traverse the rejection of claims 3-5, 7-9, 12, 13, and 16 under 35 U.S.C. § 102(e) as being anticipated by Buist.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” See M.P.E.P. § 2131, quoting Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Further, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” See M.P.E.P. § 2131, quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 3, as amended, recites a combination including, for example, “a notification step of, when said one or more conditions are satisfied at said condition detection step, notifying said customer of the satisfaction within a term of validity by electronic mail; and a displaying step of displaying the notification by the electronic mail and a notification date after notifying the satisfaction.” Buist fails to disclose at least these features of amended claim 3.

Buist discloses a system and method for conducting securities transactions over a computer network. In Buist, “the user chooses the criteria for the alert function and display options, and the application transmits 3050 the user’s alert preferences to the replica server, which . . . sends an alert (along with relevant stock information) to the user’s application when appropriate (see 3060). In response, the application , at step 3065, displays the alerts in the stock summary display and may provide an audible alert. At step 3070, the user receives the alert(s) and selects the stock from the stock summary display for detailed view in the order book.” Buist, column 23, lines 41-54.

However, Buist’s teaching of sending an alert including relevant stock information does not constitute “a notification step of, when said one or more conditions are

satisfied at said condition detection step, notifying said customer of the satisfaction within a term of validity by electronic mail,” as recited by amended claim 3 (emphasis added).

In fact, Buist does not mention any term of validity. Buist discloses that “[t]he ‘Message’ button 5030 flashes when the user has e-mail messages, and clicking the the button opens the email window. Clicking the ‘Expand’ button 5035 opens the stock summary display (see FIG. 16) and closes the compressed display.” Buist, column 34, lines 27-32. However, Buist’s mere teaching of opening and displaying email messages does not constitute “a notification step of, when said one or more conditions are satisfied at said condition detection step, notifying said customer of the satisfaction within a term of validity by electronic mail,” as recited by amended claim 3 (emphasis added).

Furthermore, Buist fails to disclose Applicants’ newly added feature “a displaying step of displaying the notification by the electronic mail and a notification date after notifying the satisfaction,” as recited in amended claim 3 (emphasis added).

Therefore, Buist fails to disclose each and every element of amended claim 3. Buist thus cannot anticipate amended claim 3 under 35 U.S.C. § 102(e). Accordingly, Applicants respectfully request withdrawal of the Section 102(e) rejection of amended claim 3. Because claims 4, 5, and 7-9 depend from claim 3, Applicants also request withdrawal of the Section 102(a) rejection of claims 4, 5, and 7-9 for at least the same reasons stated above.

Further, amended independent claims 12 and 16, while of different scope, include similar recitations to those of amended claim 3. Amended claims 12 and 16 are

therefore also allowable for at least the same reasons stated above with respect to amended claim 3. Applicants respectfully request withdrawal of the Section 102(e) rejection of amended claims 12 and 16 and of claim 13, which depends from claim 12.

Regarding the rejection under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Buist in view of Hiroataka, because a *prima facie* case of obviousness has not been established.

To establish a *prima facie* case of obviousness based on a combination or suggestion of prior art, "Office personnel must articulate . . . a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference." M.P.E.P. § 2143.A (8th edition, revision 6).

Claim 17 depends from claim 3. As set forth above, Buist fails to teach or suggest at least "a notification step of, when said one or more conditions are satisfied at said condition detection step, notifying said customer of the satisfaction within a term of validity by electronic mail; and a displaying step of displaying the notification by the electronic mail and a notification date after notifying the satisfaction," as recited in amended claim 3 and required by claim 17.

Hiroataka fails to cure the deficiencies of Buist. The Examiner alleges that "Hiroataka teaches wherein the technical index includes a relative strength index (RSI) obtained from a psychological line (pg. 1-14)." (Office Action at 7-8.) Even assuming the Examiner's allegation is correct, which Applicants do not concede, Hiroataka fails to

teach or suggest the above listed elements as recited in amended claim 3 and required by claim 17.

Therefore, neither Buist nor Hirota, taken alone or in any reasonable combination, teaches or suggests all elements required by claim 17, a *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawal of the Section 103(a) rejection of claim 17.

Conclusion


In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: February 11, 2008

By: 
Wenye Tan
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Attachments: **A copy of PTO/SB/08 form in the IDS filed 12/6/2005**